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EXAMINER				
BINDA, GREGORY JOHN				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

10/586,266

Applicant(s)

BERTANI, ROMOLO LORENZO

Examiner

Greg Binda

Art Unit

3679

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 17-29 is/are rejected.
- 7) ☒ Claim(s) 14-16 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 July 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-8508)
- Paper No(s)/Mail Date ____
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date ____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____

Drawings

1. The drawings are objected to because:
 - a. They fail to show the limitations of claims 16, 18-21 & 24-29.
 - b. They fail to show the gradation or peripheral scale required to provide the limitations recited in claim 5. see page 16, line 15.
2. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

3. The disclosure is objected to because:

- a. Page 8, line 22, the housing element is identified by a reference numeral that is later used to identify a mounting attachment.
 - b. Page 15, line 12, the proximal housing element is identified by the wrong reference numeral.
 - c. Page 16, line 19 includes the nonsensical phrase, “the locking nuts 334, 344 is at least partially engaged”
 - d. Page 16, lines 20 & 21 includes the nonsensical phrase, “the retainer member 332, 342 are then engaged”
4. The incorporation of essential material in the specification (see page 10, lines 16 & 17) by reference to an unpublished U.S. application, foreign application or patent, or to a publication is improper. Applicant is required to amend the disclosure to include the material incorporated by reference, if the material is relied upon to overcome any objection, rejection, or other requirement imposed by the Office. The amendment must be accompanied by a statement executed by the applicant, or a practitioner representing the applicant, stating that the material being inserted is the material previously incorporated by reference and that the amendment contains no new matter. 37 CFR 1.57(f).

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 5, 18-21, 24 & 27 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

a. Claim 5 recites the limitation, “said housing is lockable at a predetermined angular position”. At page 16, line 15, the specification discloses that a gradation or peripheral scale is needed to provide this capability, but the drawings do not show any such feature, nor is there any further explanation in the specification of how such a feature would be included in the disclosed invention.

b. Claim 18 recites “said housing includes a light source”. The specification mentions a light source, but no such source is shown in the drawings, nor is there any further explanation in the specification of how such a feature would be included in the disclosed invention. The only structure associated with the light source that is disclosed is a recess in one of the housing elements. There is no explanation of how the light source would be fed power or how it would be controlled.

c. Claim 19 recites “said housing includes a coolant delivery means”. The specification mentions coolant delivery means, but no such means is shown in the drawings, nor is there any further explanation in the specification of how such a feature would be included in the disclosed invention.

d. Claim 20 recites that the drive shaft, driven shaft, a universal joint and the housing are integrally formed. However, the specification clearly teaches them formed as

separate parts. There is no suggest of integrally forming them nor is it clear how that could be done without destroying the invention.

e. Claims 21 & 24 recite "said driven shaft and said drive shaft are coupled with said housing to allow vibrational axial translation". The specification mentions allowance for axial translation, but there is no further explanation in the specification of how such a feature would be included in the disclosed invention. Claim 27 recites similarly.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claim 20 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 20 recites the limitation "said at least one universal joint". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-8 & 17-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Carns, US 3,418,828. Fig. 1 shows a multidirectional transmission than can be used for a rotary hand-tool comprising:

a drive shaft 19 having a first axis of rotation, said drive shaft being adapted to be detachably rotationally coupled to an output shaft of a rotary hand-tool;

a driven shaft 21 having a second axis of rotation; at least one intermediate shaft 12, 14 rotationally coupled between said drive shaft and said driven shaft via at least two universal joints 18 (see also "a similar universal joint" at col. 2, line 55); and

a housing (see Fig. 4) adapted to receive said drive shaft, said at least one intermediate shaft and said driven shaft, said housing being adapted to allow the axis of rotation of the driven shaft to be adjustably inclined relative to the axis of rotation of the drive shaft and adjustably rotated thereabout the axis of rotation of the drive shaft.

11. Claims 1-13 & 17-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Hawn, US 2,501,217. Hawn shows a multidirectional transmission for a rotary hand-tool comprising: a drive shaft 36 having a first axis of rotation, said drive shaft being adapted to be detachably rotationally coupled to an output shaft 11 of a rotary hand-tool 10; a driven shaft 38 having a second axis of rotation; at least one intermediate shaft 37 rotationally coupled between said drive shaft and said driven shaft via at least two universal joints 41; and a housing (see Fig. 5) adapted to receive said drive shaft, said at least one intermediate shaft and said driven shaft, said housing being adapted to allow the axis of rotation of the driven shaft to be adjustably inclined relative to

the axis of rotation of the drive shaft and adjustably rotated thereabout the axis of rotation of the drive shaft.

Figs. 1 & 4 show the housing is adapted to be coupled to the rotary hand-tool 10 via a mounting attachment 14, 15.

Fig. 4 shows the housing is lockable at a predetermined angular position in relation to the axis of rotation of the output shaft of the rotary hand-tool. See also col. 3, line 23.

Fig. 1 shows the drive shaft 36 is journal led 13 to the housing at the input end of the housing, and the driven shaft 38 is journal led 43 to the housing at the output end.

Fig. 1 shows the housing includes at least three substantially cylindrical housing elements 16-20 arranged end to end, said housing elements having a passage formed therethrough lying substantially along a longitudinal axis of the housing and being adapted to receive the transmission shafts.

Fig. 1 shows the housing elements further include a seating surface lying in a plane (see also "planes" at col. 2, line 54) inclined at oblique angle (see col. 2, line 55) to the longitudinal axis of the housing element, wherein the relative orientation of adjacent housings elements is adjustable (see col. 3, lines 12+) by rotation of the adjacent housing elements about the normal axis to said seating surface.

Figs. 1, 4 & 7 show the housing includes a lock 31 adapted to fix one housing element relative to an adjacent housing element to allow the axis of rotation of said drive shaft to be fixed relative to the axis of rotation of said driven shaft at a selected orientation.

Allowable Subject Matter

12. Claims 14-16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Greg Binda whose telephone number is (571) 272-7077. The examiner can normally be reached on M-F 10:30 am to 8:00 pm with alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (571) 272-7087. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Greg Binda/
Primary Examiner, Art Unit 3679